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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Benson, et al.

) Group Art Unit 2777

Appl. No. : 09/321,386

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) Commissioner for Patents, Washington, D.C.
) 20231, on

Filed : May 27, 1999

For : METHOD AND SYSTEM FOR
MANAGING A DATA OBJECT SO
AS TO COMPLY WITH
PREDETERMINED CONDITIONS
FOR USAGE

February 15, 2000

(Date)

Eric M. Nelson, Reg. No. 43,829

Examiner : M. Von Buhr

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to an Office Action dated November 1, 1999, Applicant has the following remarks.

Discussion of Rejections Under Non-Statutory Double Patenting

In the Office Action, the Examiner rejected Claims 1-53 under the judicially created doctrine of non-statutory double patenting over Claims 1-29 of U.S. Patent No. 5,845,281 to Benson ('281 patent). Furthermore, the Examiner provisionally rejected Claims 1-53 under this doctrine over Claims 1-69 of Application No. 09/164,606 ('606 application). In response, Applicant encloses herewith a terminal disclaimer with respect to the '281 patent and a terminal disclaimer with respect to the '606 application. Accordingly, Applicant respectfully submits this doctrine has been removed as a basis of rejection.

Discussion of Inventorship

In the Office Action, the Examiner took the position that Claims 1-53 are directed to the same invention as that of Claims 1-29 of the '281 patent and Claims 1-69 of the '606 application. The Examiner stated that the issue of priority under 35 U.S.C. § 102(g) and the

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issue of derivation under 35 U.S.C. § 102(f) with respect to the '281 patent and the '606 application must be resolved.

Applicant respectfully submits that the inventors of the '281 patent, the '606 application, and the present application are all the same, namely, Greg Benson, Gregory Urich, Christopher Knauft. On July 8, 1999, Applicant's attorney filed a petition under 37 C.F.R. § 1.324 to add Christopher Knauft as a named inventor in the '281 patent, Greg Benson and Gregory Urich being the other two named inventors. Furthermore, on April 20, 1999, Applicant's attorney filed a petition under 37 C.F.R. § 1.48(a) to add Christopher Knauft as a named inventor in the '606 application, Greg Benson and Gregory Urich being the other two named inventors. Greg Benson, Gregory Urich, Christopher Knauft are the named inventors for the present application.

Since the inventors for each of these cases are the same, Applicant respectfully submits that the '281 patent and the '606 application are not prior art under 35 U.S.C. § 102(g) or (f) with respect to the present application.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, she is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/15/2000

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